

REMARKS/ARGUMENTS

This Application has been carefully reviewed in light of the Office Action mailed January 18, 2007, which supersedes the Office Action (restriction requirement) dated September 28, 2006. Claims 23-25 were previously withdrawn without prejudice, and this grouping has been reiterated in the pending requirement.

Thus, Claims 1-22 and 26-70 were in this Application. Claims 23-42 and 56-70 are withdrawn without prejudice. Claims 1-22 and 43-55 are currently pending in this Application.

The Examiner has required election under 35 U.S.C. § 121 to elect from among three groups. Group I (Claims 1-22 and 43-55) is drawn to a fiber cement product with a removable protective layer, Group II (Claims 26-42 and 56-70) is drawn to a method of adhering a protective layer to a finish layer, and Group III (Claims 23-25) is drawn to a method of constructing a building (Group II). Applicants hereby elect Group I (Claims 1-22 and 43-55) for prosecution on the merits.

The Examiner has further required election of species upon the election of Group I (see above). Applicants hereby provisionally elect Species 1A, upon which Claims 1-8 and 15-22 read upon. Applicants, however, traverse the requirement for an election of species.

TRAVERSE

Every requirement to restrict has two aspects, (1) the reasons (not conclusory statements) why the inventions *as claimed* are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween. MPEP § 808. [Emphasis in the original]. With regard to the second aspect, the reasons under MPEP § 808 given by the Examiner for insisting upon exercising his authority under 35 U.S.C. § 121 to require restriction must be reasons approved by the Commissioner. The reasons approved by

the Commissioner are set out in MPEP § 803: (1) the inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 and § 806.05(i)); and (2) there must be a serious burden on the Examiner if restriction is not required (see MPEP § 803.02, § 806.04(a)-(j), § 808.01(a) and 808.02). The Examiner must provide reasons and/or examples to support conclusions. MPEP § 803. Applicants respectfully assert that the requirements of MPEP § 803 also have not been met.

With regard to the first aspect, the Office Action fails to provide a reason as to why each of the species identified in the Action are independent and distinct, as claimed. "Where inventions as disclosed and claims are both (A) species under a claimed genus and (B) related, the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions..." MPEP 806.04(b). The Examiner has not shown why spacers as claimed are independent or distinct inventions under their restriction under Claim I (noting that this may be a typographical error for Group I). The Examiner has also not shown how the species are related. Unless the Examiner can show otherwise, it is further not apparent that the Examiner's current restriction reflect proper species nor does it reflect species that are mutually exclusive. MPEP 806.04(f). Moreover, a serious burden on the Examiner may be shown, *prima facie*, if the Examiner provides, by appropriate explanation, either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. This standard applies to an election of species requirement as well. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. MPEP § 803. Applicants respectfully assert that the Examiner has failed to make a *prima facie* case that

restriction of the species is required. The Office Action to which this reply is responsive provides no reason as to why the species as *claimed* are either independent or distinct and it fails to establish how it imposes a serious burden upon the Examiner in the absence of a species election. Rather, it merely provides a conclusion that such is the case, and relies upon a "one figure, one species" categorization based upon the drawings. Therefore, Applicants respectfully assert that the *prima facie* requirements of MPEP § 803 have not been met.

CONCLUSION

Applicants have elected Group I (Claims 1-22 and 43-55) and provisionally elected Species 1A for further prosecution on the merits, but have traversed the Examiner's election-of-species requirement, particularly the grouping and the basis in support of it.

Applicants respectfully submit that the Application is in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

No fees are believed due, however, Applicants hereby authorize the Commissioner to charge any additional fees or refunds that may be required by this paper to Gardere Wynne Sewell LLP Deposit Account No. 07-0153. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to Gardere Wynne Sewell LLP Deposit Account No. 07-0153.

Please direct all correspondence to the practitioner listed below at Customer No. 32914.

Respectfully submitted,



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